

United States District Court,
E.D. Pennsylvania.

The NEW L & N SALES AND, MARKETING, INC. and Rommy Hunt Revson,
Plaintiffs / Counterclaim Defendants.

v.

MATTEL, INC. and Toys 'R US, Inc,
Defendants / Counterclaim Plaintiffs.

No. CIV. A. 99-590

June 8, 2000.

MEMORANDUM

NEWCOMER.

Presently before this Court are defendants' Motion for Summary Judgment, plaintiff's Response thereto, defendants' Reply thereto and additional briefing requested by the Court on June 1, 2000. This Court originally issued an Order and accompanying Memorandum on May 19, 2000 denying defendants' Motion for Summary Judgment. On June 1, 2000, this Court vacated its Order and withdrew its Opinion, sua sponte, in order to request additional briefing on the issue of any binding effects of the 1999 Arbitration Award and subsequent Settlement Agreement between L & N and Revson on the action presently pending before this Court. For the following reasons, defendants' Motion for Summary Judgment is DENIED and the original Memorandum is amended.

I. BACKGROUND

This action concerns U.S. Patent No. Des. 292,030 (" '030 Patent") and subsequent licenses of the '030 Patent to various parties. The '030 Patent was issued to plaintiff Rommy Hunt Revson on September 22, 1987 for an ornamental hairband or similar article. FN1 Plaintiff The New L & N Sales & Marketing, Inc. contends that defendants Mattel, Inc. and Toys "R" Us, Inc. have infringed the '030 Patent and violated L & N's rights from a license of the Patent, whereas defendants argue that they have rights under the Patent from Mattel's own valid license of the same design patent.

FN1. On June 12, 1990, Riviera Trading Corporation formally requested the PTO for reexamination of the '030 Patent, alleging that it had been anticipated or made obvious by prior art. On August 7, 1990, that request was denied.

On October 25, 1994, Revson and L & N signed a License Agreement ("L & N Agreement") that was effective "[a]s of February 11, 1993 ." Revson represented and warranted in the L & N Agreement that she had "the right and power to enter into [the] Agreement and that she [was] the owner of the entire right, title

and interest in and to" U.S. Design Patent 292,030. The L & N Agreement subsequently granted to L & N and its subsidiaries and affiliates, *inter alia*, "The Exclusive License to make, have made, use and sell stretch ponytail holders covered by the '030 Patent in the Exclusive Territory" as defined by the Agreement, and "The Non-Exclusive License to make, have made, use and sell stretch ponytail holders covered by the '030 Patent in the Non Exclusive Territory" as defined by the Agreement. The L & N Agreement was to remain in full force and effect for the life of the '030 Patent unless terminated under the provisions set forth in the Agreement.

In 1994, Tyco Industries, Inc. FN2 approached Revson for a license under the '030 Patent for a product called "Scrunch 'n Wear." Scrunch 'n Wear has been referred to by both L & N and Mattel as a craft kit which enables children to construct and assemble hair accessories. The product identifies itself on the cover of its box as a "Hairwear Making Set," whereby children as young as six years old can "Make Super-Size Hair Scrunches!" The box further proclaims that the kit "Makes 13 Scrunch Hair Accessories!"

FN2. Tyco Industries, Inc. originally dealt with Revson and entered into a License Agreement with her. However, Tyco subsequently merged with defendant Mattel and the two will be collectively referred to as "Mattel."

In November 1994, Mattel and Revson entered into a License Agreement ("Mattel Agreement"). The Mattel Agreement indicated that Mattel was "desirous of obtaining the right to manufacture, distribute and sell a child's CRAFT SET which allows the child to make hair accessories, including ornamental hair bands, such as the one protected by U.S. Design Patent No. 292,030." (capitalization in original). Consequently, the Agreement granted Mattel the "right to manufacture, to have manufactured for it, to use, distribute and to sell the CRAFT SET worldwide." In addition, paragraph 12 of the Mattel Agreement warranted that Revson was "the sole and exclusive owner of all rights to U.S. Design Patent No. 292,030," and that she had "the right and the ability to give and grant the License ... to the LICENSOR." (capitalization in original).

Beginning in 1995, Mattel marketed its Scrunch 'n Wear crafts kits and they became very successful products for the company at least through 1997. In 1996, subsequent to the introduction of Scrunch 'n Wear to the market, Rose Art Industries, Inc. introduced a competing product called "Super Scrunchtastic." In January 1997, Tyco Industries, Inc. and Rommy Hunt Revson filed a Complaint in the District Court in New Jersey against Rose Art Industries, Inc. for unfair competition in the nature of trade dress infringement, false representations and false advertising, and for patent infringement. Mattel eventually settled the claims against Rose Art pursuant to a non-monetary settlement agreement in which Rose Art promised to change its packaging.

In 1996, upon learning of her license with Mattel, L & N complained to Revson that it considered the manufacture and sale of the Mattel craft kits an infringement of L & N's rights under the '030 Patent. In June 1996, that question was submitted along with other issues to arbitration before the American Arbitration Association as provided in the L & N Agreement. Mattel was not a party to the arbitration. An arbitration award was entered on January 13, 1999 ("Arbitration Award"), whereby the arbitrators held that Revson had "no right to grant a license under the '030 Patent" to Mattel and ordered that she turn over to L & N the royalties she had received from Mattel.

On February 2, 1999, Revson and L & N entered into a settlement agreement ("L & N Settlement Agreement") which incorporated many of the arbitrators' findings. Specifically, paragraph 2(A)-(B) stated in

relevant part:

It is the intention of the parties ... not to in any way modify, change, affect or limit the [Arbitration] Award as to Revson's breach of contract and/or inducement to infringe relating to [Mattel]. The findings of the Award that Revson "has no right to grant a license under the ['030 [P]atent to [Mattel] and such grant constitutes a breach of the subject Agreement" and that such action by Revson constituted a "breach of contract and/or inducement to infringe" remain in full force and effect, although Revson does not agree with the Arbitrators' ruling.

The L & N Settlement Agreement also amended several sections of the original L & N Agreement, including, paragraph 1.a. of Section C entitled " *GRANT OF LICENSE* ", which was amended to read as follows: "The Exclusive License to make, have made, use and sell stretch ponytail holders, including craft sets which allow the user to make hair accessories including ornamental hair bands such as those covered by the '030 Patent, throughout the United States, its territories and possessions."

Plaintiffs L & N and Revson have now brought this patent infringement suit seeking to recover the substantial profits defendants have allegedly enjoyed from their knowing and willful sales of stretch ponytail holders in craft kits that infringe L & N's rights as the exclusive licensee of the '030 Patent.

Defendants Mattel and Toys "R" Us have now filed a Motion for Summary Judgment on two grounds: (1) Mattel had a valid license under the '030 Patent from Revson, and its actions with respect to selling the Scrunch 'n Wear craft kits therefore could not constitute patent infringement; and (2) the '030 Patent is invalid because the claimed design was anticipated and rendered obvious by the prior art Ribbonbands, Silkies, and Stretchies.

A. SUMMARY JUDGMENT STANDARD

A reviewing court may enter summary judgment where there are no genuine issues as to any material fact and one party is entitled to judgment as a matter of law. *White v. Westinghouse Elec. Co.*, 862 F.2d 56, 59 (3d Cir.1988). The evidence presented must be viewed in the light most favorable to the non-moving party. *Id.* "The inquiry is whether the evidence presents a sufficient disagreement to require submission to the jury or whether it is so one sided that one party must, as a matter of law, prevail over the other." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). In deciding the motion for summary judgment, it is not the function of the Court to decide disputed questions of fact, but only to determine whether genuine issues of fact exist. *Id.* at 248-49. An issue is only "genuine" if there is sufficient evidence with which a reasonable jury could find for the non-moving party. *See id.* at 249. Furthermore, bearing in mind that all uncertainties are to be resolved in favor of the non-moving party, a factual dispute is only "material" if it might affect the outcome of the suit under governing law. *See id.* at 248.

The moving party has the initial burden of identifying evidence which it believes shows an absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986); *Childers v. Joseph*, 842 F.2d 689, 694 (3d Cir.1988). The moving party's burden may be discharged by demonstrating that there is an absence of evidence to support the nonmoving party's case. *Celotex*, 477 U.S. at 325. Once the moving party satisfies its burden, the burden shifts to the nonmoving party, who must go beyond its pleadings and designate specific facts, by use of affidavits, depositions, admissions, or answers to interrogatories, showing that there is a genuine issue for trial. *Id.* at 324. Moreover, when the nonmoving party bears the burden of proof, it must "make a showing sufficient to establish the existence of [every] element essential to that

party's case." *Equimark Commercial Fin. Co. v. C.I.T. Fin. Servs. Corp.*, 812 F.2d 141, 144 (3d Cir.1987) (quoting *Celotex*, 477 U.S. at 322). Summary judgment must be granted "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial ." *White*, 862 F.2d at 59 (quoting *Celotex*, 477 U.S. at 322).

II. DISCUSSION

A. VALIDITY OF THE MATTEL AGREEMENT

Mattel argues that it did not infringe the '030 Patent because it had a valid license from Revson to market its Scrunch 'n Wear products. Mattel contends that its License Agreement is valid because Revson granted it rights to the '030 Patent that legitimately belonged to her. Mattel argues that the L & N Agreement, in clear and unambiguous terms, grants L & N rights only to assembled "stretch ponytail holders" and specifically excludes products such as Scrunch 'n Wear craft kits that are not marketed primarily as ponytail holders.

L & N counters Mattel's arguments by positing that its license from Revson granted it all of the significant rights that Revson had in the patent—the rights to exclude others from making, using and selling products embodying the design depicted in the patent drawing. L & N contends that the plain language of the L & N Agreement shows that the scope of L & N's license was co-extensive with the scope of the '030 Patent, and not just limited to assembled stretch ponytail holders. L & N argues, therefore, that Revson assigned her entire bundle rights under the '030 Patent to L & N, had no subsequent rights to grant to Mattel, and thereby rendered the Mattel Agreement invalid. L & N further maintains that Mattel's craft kits are stretch ponytail holders, or more precisely a means for making stretch ponytail holders comprising an annulus fabric tube surrounding an interior elastic band; and as such, the Scrunch 'n Wear product falls within the scope of the license granted to L & N.

In the instant case, the 1999 Arbitration Award plays a determinative role in assessing the validity of the Mattel Agreement. In 1996, L & N and Revson submitted to an arbitration hearing for various contractual disputes as provided for in the L & N Agreement. In 1999, the arbitrators handed down the Arbitration Award. Subsequently, L & N and Revson entered into the L & N Settlement Agreement. Most importantly, however, both parties ultimately agreed to be bound by the Arbitration Award with respect to certain findings, as described above. While L & N and Mattel have briefed this Court extensively on the issues of res judicata and collateral estoppel, this Court determines that the application of such doctrines is not necessary here.

The most telling portion of the Arbitration Award for the purposes of the instant Motion is the finding in Paragraph 1(f) that Revson had "no right to grant a license under the ['030 [P]atent to [Mattel] and such grant constitutes a breach of the [L & N] Agreement." The Court finds that the language of the Award clearly states that Revson had no rights to grant a license to Mattel concerning *anything* covered by the '030 Patent. The arbitrators determined that pursuant to the L & N Agreement Revson retained no rights under the '030 Patent to grant to Mattel. Therefore, at the time Revson entered into the Mattel Agreement, she had already given all her rights under the '030 Patent to L & N.

To the extent that Revson agreed to be bound by the Arbitration Award, this Court has no choice but to honor the arbitrators' Award and determine that as a matter of law she had no right to grant a license to Mattel. As L & N indicates in its brief, Mattel's rights as a licensee derive from, and can never exceed, those of the licensor, Revson. Consequently, the Arbitration Award was conclusive in determining the scope of Revson's rights, and Mattel is precluded from claiming to have a valid license under the '030 Patent when

Revson, herself, did not have the rights she attempted to grant to Mattel in the Mattel Agreement. Thus, the Court need not determine the estoppel effects of the Arbitration Award on Mattel because the Award's binding effects on Revson necessarily invalidate her agreement with Mattel.

Accordingly, defendants Motion for Summary Judgment as to whether Mattel's activities were conducted under a valid license from the inventor is denied and the Court finds that the Mattel Agreement is invalid as a matter of law. As defendant Mattel suggests, however, the issue of whether Mattel's craft kits in fact infringe the '030 Patent, as well as the proof of any resulting damages, is an issue still to be determined at trial.

B. '030 PATENT VALIDITY

Defendants also argue that the '030 Patent is invalid because the claimed design was anticipated by several products called "Ribbonbands," "Silkies," and "Stretchies" that were sold in the early to mid 1980s, and because the design is obvious in light of the prior art. Plaintiffs counter defendants contentions by asserting that Mattel is judicially estopped FN3 from asserting patent invalidity, barred by assignor estoppel FN4 from asserting patent invalidity, and that defendants fall short of demonstrating the invalidity of the '030 Patent by clear and convincing evidence.

FN3. Judicial estoppel does not apply to Mattel here for a variety of reasons. Among other things, the Rose Art litigation was resolved through a settlement agreement, and so Mattel's contentions cannot be considered to have been successfully maintained. *Associated Hospital Service of Philadelphia v. Pustilnik*, 439 A .2d 1149 (1981). Moreover, while Mattel's position in the current legal proceeding arguably contradicts or is inconsistent with a previously asserted position, there is insufficient evidence to show that Mattel asserted either or both inconsistent positions in bad faith. *Ryan Operations G.P. v. Santiam-Midwest Lumber Co.*, 81 F .3d 355, 361 (3d Cir.1996).

Moreover, the Court agrees that even if Mattel is barred from raising a claim for invalidity, Toys "R" Us is not.

FN4. While assignor estoppel historically has applied to invalidity challenges based on "novelty, utility, patentable invention, anticipatory matter, and state of the art" *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed.Cir.1988) (citations omitted), it does not apply here because it is not an assignor of a patent attacking the validity of the patent here. Assignor estoppel is an equitable doctrine that prevents one who has assigned rights to a patent from later contending that what was assigned is a nullity.

A design patent may be issued for "any new, original and ornamental design for an article of manufacture." 35 U.S.C. § 171. In order to be valid, a design patent "must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman ... A design patent cannot be obtained to protect a mechanical function or cover an article whose configuration affects its utility alone." *Spaulding v. Guardian Light Co.*, 267 F.2d 111, 112 (7th Cir.1959) (citations omitted).

In addition, patents are presumed valid by statute, *see* 35 U.S.C. s. 282 (1994), and "[t]he burden is on the party asserting invalidity to prove it with facts supported by clear and convincing evidence." *SSIH Equip., S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 375 (Fed.Cir.1983). The burden of showing, by clear and convincing evidence, the invalidity of patent claims is especially difficult when the prior art was

before the PTO examiner during the prosecution of the application. *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1467 (Fed.Cir.1990). Where there is "no PTO view ... on obviousness in view of [the asserted] references[,] the burden of proof ... is more easily carried." *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 905 (Fed.Cir.1985). Regardless, the burden of proof on invalidity remains with the party challenging the patent. *See Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed.Cir.1986).

1. CLAIM CONSTRUCTION

Both parties dispute the construction of the '030 Patent, which compels the Court to begin its analysis of validity by construing the meaning and scope of the Patent. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1574 (Fed.Cir.1995). Claim construction is a matter of law for the courts to decide. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370 (1996). Claim construction must be based on intrinsic evidence of record, i.e., the patent claim, its description or specification and, if in evidence, the prosecution history. *Bell & Howell Document Mgmt. Prds. Co. v. Altek Sys.*, 132 F.3d 701, 705 (Fed.Cir.1997). The prosecution history-the "undisputed public record" of proceedings in the PTO-is of primary significance in understanding the claims. *Markman*, 52 F.3d at 980. "The requirement that the court construe disputed claim language, as applied to design patents, must be adapted to the practice that a patented design is claimed as shown in its drawing. There is usually no description of the design in words." *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1116 (Fed.Cir.1998) (citing 37 C.F.R. s. 1.153(a)).

In the instant case, the patent claim limits Revson's patent rights to "The ornamental design for an ornamental hairband or similar article, substantially as shown and described." The drawing of the patent is depicted in four figures, which represent various perspective views of the hairband and different uses of the article as a hairband and ornamental bracelet. The patent description indicates the specific view and embodiment contained in each of the drawings.

The parties specifically disagree over the '030 Patent's point of novelty. Defendants argue that the patent drawings, the prior art, and the statements of Revson's prosecuting attorney in distinguishing the prior art all strongly suggest that the "novelty" Revson claimed in her '030 design was a "very full pleated floppy or fluffy look" as compared to the less full appearance of the "Ribbonbands," which were described by the prosecuting attorney as "devoid of ... large floppy pleats." Defendants claim that this intrinsic evidence unambiguously demonstrates that the claim of the design, properly construed, is directed to its full, pleated floppy or fluffy look. L & N identifies the '030 Patent's point of novelty as an irregular donut-like overall shaped hairband, having a body height less than body width, a body opening similar to the body width, and generally radially extending fluffy folds.

The Court disagrees with defendants, to the extent that their representation of Revson's prosecuting attorney's description is less than fully accurate. In comparing Revson's product with the "Ribbonbands" product, Revson's prosecuting attorney noted that "the width of the cloth tube is small as compared with the diameter of the annulus whereby to render the prior product of the large floppy pleats of [Revson's] band. It is this aesthetic quality *among others* that sets [Revson's] band aesthetically apart from [the Ribbonbands] product " (emphasis added).

After considering the patent document in conjunction with the prosecution history, the Court construes the scope of the '030 Patent claim to include the overall ornamental visual impression of the following: (1) an

overall annular, ring-like, and torus shape; (2) a top plan view showing an open center with a diameter approximately equal to the surrounding width of the ring's body; (3) a side elevational view showing a thickness that appears less than the width of the ring's body; (4) a perspective view in a position of use whereby the article is wrapped around an arm and the thickness of the article does not appear to be as less than the width of the ring's body as it did from the side elevational view; and (5) a wrinkled, uneven look to the surface of the ring consisting of pleats and folds.

2. ANTICIPATION BY PRIOR ART

Patent invalidity based on anticipation is a question of fact. *See Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed.Cir.1995). Anticipation is established if every element of a properly construed claim is present in a single prior art reference. *See id.* "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found.*, 927 F.2d at 1576. It has also been held that:

In determining whether a patented invention is anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described. If needed to impart clarity or avoid ambiguity, the prosecution history and the prior art may also be consulted in order to ascertain whether the patentee's invention is novel or was previously known to the art.

Glaverbel, 45 F.3d at 1554. The basic test for anticipation is: "that which infringes, if later, anticipates, if earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573 (Fed.Cir.1986), *cert. denied*, 479 U.S. 850 (1986)(commas added to reflect the original quote from *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889)).

In *Finnigan Corp. v. Int'l Trade Common*, 180 F.3d 1354 (Fed.Cir.1999), the Federal Circuit Court described how courts have long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence absent other evidence that corroborates that testimony. *Id.* at 1366. "The Supreme Court recognized over one hundred years ago that testimony concerning invalidating activities can be 'unsatisfactory' due to 'the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury.'" *Id.* (quoting *The Barbed-Wire Patent*, 143 U.S. 275, 284 (1892)).

Defendants have produced written declarations and deposition testimony of six witnesses who corroborate that various elasticized hair accessories were made and sold in the early to mid-1980s by The Body Shop, a California company that sold personal care items, including hair care items such as hair clips, pins, and ponytail holders called Ribbonbands, Silkies, and Stretchies. Defendants have also produced photographs of actual specimens of these ponytail holders, maintaining that they sufficiently invalidate the '30 Patent, based on grounds of either anticipation or obviousness.

L & N contends that Mattel cannot rely on Ribbonbands as prior art because Revson already disclosed and described them to the PTO when she filed her application in December 1986. L & N also posits that Silkies were made by reverse-engineering a Ribbonbands product, and therefore were simply copies of Ribbonbands and cannot invalidate the '030 Patent. Finally, L & N asserts that there is no clear and convincing evidence that Stretchies were sold or available more than one year prior to the '030 Patent application, and therefore, defendants' evidence is insufficient to invalidate the '030 Patent.FN5 In the alternative, L & N points to expert testimony that suggests there are distinct differences between Stretchies

and the '030 Patent design.

FN5. Stretchies apparently have been discovered recently and have not been disclosed or described as prior art to any court or the PTO until the instant case.

Defendants' evidence regarding the manufacture and marketing of the anticipating ponytail holders specifically includes: (1) the written declaration and deposition testimony of Elen Pass Brandt, a former employee and buyer for The Body Shop; (2) the written declaration and deposition testimony of Colleen Larkin, who created, manufactured, and sold fabric covered elastic ponytail holders called Ribbonbands during the period 1980-1984; (3) the deposition testimony of Manda Heron, who has worked at The Body Shop (which was started by her mother and aunt) since 1971 and currently owns Body Time (formerly The Body Shop); (4) the written declaration of Colyne Kiefer-Elmore, a former employee of The Body Shop; (5) the written declaration of Chong Sook You, an employee of The Body Shop from 1976 to 1992 who manufactured the Silkies and Stretchies for the store; (6) the written declaration of Maria Barra, an employee of Body Time and former employee of The Body Shop; and (7) various photographs of samples of Ribbonbands, Silkies, and Stretchies. While defendants have produced evidence to suggest that Stretchies and other products may have existed prior to the '030 Patent, it is true that said evidence consists of only affidavits and photographs, without any corroborating documentary evidence.FN6

FN6. The Court does find, however, that there is sufficient documentary evidence that Colleen Larkin created, manufactured, and sold Ribbonbands. It is namely the Stretchies product whose existence, and more importantly, whose period of existence, is at issue.

The Court, however, has no reason to doubt the uncontroverted evidence produced by defendants that The Body Shop developed ponytail holders from Ribbonbands to Silkies to Stretchies. Each of the declarations and depositions were submitted under penalty of perjury. Furthermore, none of defendants' witnesses who testified to the existence of the Ribbonbands, Silkies, and Stretchies have an interest in the current litigation. While Ms. Larkin admits to being compensated for her testimony, Ms. Brandt and Ms. Heron specifically testified that they were testifying voluntarily, without compensation, and that they had no interest in the instant litigation. Regardless, in deference to the opinion outlined in *Finnigan* and in consideration of the drastic nature of invalidating an existing patent, the Court refrains at the present time from making any rulings on the factual issue of anticipation and determines that judging the credibility of the undocumented evidence is better reserved as a matter for the factfinder.

In addition, L & N has produced rebuttal expert testimony from Cooper C. Woodring, an industrial designer, that suggests the Stretchies product "is a hairband having body height similar to body width, in contrast to the '030 design's body height being less than body width," and "[t]herefore, the '030 design is not the same as the design of Stretchies and was not anticipated by Stretchies, as the '030 design has at least one novel feature not taught by Stretchies." Said evidence, among other things, when read in the light most favorable to plaintiffs, presents a triable issue of material fact as to anticipation. Accordingly, the Court denies the Motion for Summary Judgment as to whether defendants' evidence is clear and convincing to show that the '030 Patent design was anticipated by prior art.

2. OBVIOUSNESS

A patent is invalid for obviousness under 35 U.S.C. s. 103 "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The ultimate determination of obviousness is a question of law based on underlying factual inquiries. *See Richardson-Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479 (Fed.Cir.1997). The factual inquiries involve consideration of the four so-called Graham factors: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) any secondary considerations of nonobviousness, such as commercial success. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). The factfinder must evaluate the invention, "not through the eyes of the inventor, who may have been of exceptional skill, but as by one of 'ordinary skill.'" *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed.Cir.1985). In the context of design patents, an obviousness analysis examines whether the teachings of the prior art suggest the overall appearance of the claimed design. *In re Sung Nam Cho*, 813 F.2d 378, 382 (Fed.Cir.1987).

a. SCOPE AND CONTENT OF PRIOR ART

Defendants have produced several examples of ponytail holders that arguably constitute prior art sufficient to invalidate the '030 Patent on grounds of obviousness. The Court reiterates its opinion that defendants' evidence strongly underscores a progression in the prior art from Ribbonbands to Silkies to Stretchies. To the extent, however, that the Court has reserved for the jury the issue of the credibility of the witnesses and evidence with respect to the existence and sale of Stretchies in determining anticipation, the Court will do the same for obviousness and the factual inquiry of the scope and content of the prior art.

b. DIFFERENCES BETWEEN CLAIMS AND PRIOR ART

As noted above, L & N counters defendants' arguments with evidence that suggests that there are distinct differences between Stretchies and the '030 Patent design. Cooper Woodring opines that "the '030 design is not the same as the design of Stretchies and would not have been obvious to one of ordinary skill in the art, as the appearance of the '030 design and the Stretchies design are not basically the same. They differ by at least one novel design feature, requiring new, original, non-obvious, creative and ornamental design."

This Court found in construing the '030 Patent claim above that the "side elevational view show[s] a thickness that appears less than the width of the ring's body." On the other hand, it also appeared to the Court that the perspective view, in a position of use whereby the article is wrapped around an arm, revealed that "the thickness of the article does not appear to be as less than the width of the ring's body as it did from the side elevational view." While L & N's expert testimony, when read in the light most favorable to plaintiffs, is enough to present a triable issue of material fact for the purposes of the instant Motion, this Court is not entirely convinced that there are any differences between the '030 Patent claims and the alleged prior art-i.e. the Stretchies products. Defendants have made a strong case for invalidity based on obviousness, to the extent that The Body Shop's Stretchies look uncannily similar to both the hair products produced by plaintiffs as well as the design depicted in the '030 Patent.

Nevertheless, based on the factors discussed above, among others, the Court cannot conclude by clear and convincing evidence at this time that the "Stretchies" product was sufficient prior art and whether there were differences between the '030 Patent claims and the product that would render the '030 Patent design obvious. Therefore defendants' Motion for Summary Judgment is denied as to obviousness.FN7 However, the Court notes that it is also not concluding at this time that the ' 030 Patent is not invalid, and will, if necessary, revisit this issue at trial.

FN7. The Court declines to discuss the remaining issues concerning obviousness, and rather reserves such issues for trial.

ORDER

AND NOW, this ___ day of June, 2000, upon consideration of defendants' Motion for Summary Judgment, plaintiffs' Response thereto, and defendants' Reply thereto, it is hereby ORDERED that said Motion is DENIED.

It is further ORDERED that the order of trial shall be bifurcated, whereby the issue of patent validity shall be tried before the jury first. If necessary, the issues of patent infringement and damages shall be tried with the same jury immediately following a verdict on the issue of patent validity.

AND IT IS SO ORDERED.

E.D.Pa.,2000.

New L & N and Marketing, Inc. v. Mattel, Inc.

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